

REMARKS

Claims 1-18 are pending in the application. No claims are presently allowed.

Claim 3 is amended to correct the claim dependency and to change the phrasing of the range.

No new matter has been added.

Claim Rejections – 35 U.S.C. § 112

Claim 3 has been rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The claim recited “claim 0.” This has been corrected to “claim 2.”

The claim recited “less than about 30% platinum by weight.” This has been changed to “platinum in an amount greater than 0 to about 30 percent by weight” as suggested by the Examiner.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 4, 10-12, 17, and 18 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Watanabe et al. (*J. Electrochem. Soc.*).

In order to make a *prima facie* case of anticipation, the reference must disclose each limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Among other deficiencies, the reference does not disclose the limitation in claims 1, 11, and 17 that the composition comprises a hydrate. Watanabe discloses platinum dispersed in tin oxide. No hydrate ($\cdot \text{yH}_2\text{O}$) form of tin oxide is disclosed. Although it is stated that “alkaline pretreatment of SnO_2 causes the pH response of the electrode to be enhanced, evidently though a superficial hydration,” (p. 60, col. 1, lines 36-39) hydration is defined in Watanabe as formation of --Sn--OH (p. 60, col. 1, lines 39-40). This is not the same as $\text{SnO}_x \cdot \text{yH}_2\text{O}$. As all the claim limitations have not been disclosed, a *prima facie* case of anticipation has not been made.

Claims 2, 4, 10, 12, and 18 depend from and contain all the limitations of claims 1, 11, or 17. The arguments regarding the lack of *prima facie* for claims 1, 11, and 17 are applicable to claims 2, 4, 10, 12, and 18.

Claims 1, 2, 4, 5, 12, 13, 15, and 17 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Gardner et al. (*J. Phys. Chem.*).

As in Watanabe, Gardner does not disclose a hydrate as recited in claims 1, 15, and 17. Although dehydration of the material is disclosed, this does not imply that the material had been a hydrate. Gardner discloses “surface dehydration caused by the combination of surface hydroxyl groups and desorption of water” (p. 835, col. 1, lines 27-28). The water is made from hydroxyl groups, not hydrate groups. There is no disclosure that there was ever a hydrate group present. The Examiner stated that “Pt/SnO₂ is humidified.” Humidification would indicate merely that water molecules are present. This does not show the chemical reaction needed to form the presently claimed hydrate compound. As all the claim limitations have not been disclosed, a *prima facie* case of anticipation has not been made.

Claims 2, 4, 5, 12, and 13 depend from and contain all the limitations of claims 1, 15, and 17. The arguments regarding the lack of *prima facie* for claims 1, 15, and 17 are applicable to claims 2, 4, 5, 12, and 13.

Claims 1-4 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Katayama et al. (*J. Phys. Chem.*).

As stated by the Examiner, Katayama discloses Pt/SnO₂. This is not the same as the claimed hydrate. As all the claim limitations have not been disclosed, a *prima facie* case of anticipation has not been made.

Claims 2-4 depend from and contain all the limitations of claim 1. The arguments regarding the lack of *prima facie* for claim 1 are applicable to claims 2-4.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, and 4-16 have been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Watanabe et al. (US 5,922,487, “Watanabe 487”) in view of Watanabe.

In order to make a *prima facie* case of obviousness, each claim limitation must be disclosed in the references (MPEP 2143.03). Among other deficiencies, none of the references discloses the limitation in claims 1, 11, 15, and 17 that the composition comprises a hydrate. As explained above Watanabe does not disclose a hydrate. Watanabe 487 discloses Pt/Sn alloys.

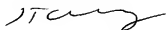
No tin oxide or hydrates are disclosed. As all the claim limitations of claim 1 are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

Claims 2, 4-10, 12-14, and 16 depend from and contain all the limitations of claims 1, 11, or 15. The arguments regarding the lack of *prima facie* for claims 1, 11, and 15 are applicable to claims 2, 4-10, 12-14, and 16.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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